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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/578,085

05/24/2000

Richard Palmeri

1008-00

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35811

7590

10/06/2006

IP GROUP OF DLA PIPER US LLP  
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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3692

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/578,085	PALMERI, RICHARD	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frantzy Poinvil	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 7/17/2006 have been fully considered but they are not persuasive.

Applicant states that Hartt et al do not teach or suggest the claimed invention and argues that in Hartt et al, the subscriber transaction information is transferred after the transaction and thereafter, the processor calculates the rebate amount and has these funds transferred to the investment.

In response, as admitted by the applicant, Hartt et al teach or suggest a subscriber performs a purchase transaction, and a processor calculates funds to be transferred to a subscriber investment account. See top of page 2 of the applicant's response. Applicant continues to state that "In sharp contrast to Hartt et al, the claimed invention electronically reallocates a portion of the transaction amount to the investment proximate in time to the transaction" and concludes that these limitations are not taught by Hartt et al.

In response, it appears that applicant is only arguing the timing of reallocating a portion of the investment while admitting that Hartt et al also teach transferring funds to an investment account of a subscriber. As noted in the prior Office action, "Hartt et al disclose an investment system wherein funds are being transferred from a vendor's account to an escrow account and then to a user investment vehicle for the user. See pages 3, line 23 to page 4, line 30 of Hartt.". The timing or the direction of which funds are transferred between the accounts of the involved entities are merely left to the decisions and agreements among the involved entities. As noted,

the structure of Burke and Hartt et al describes a vendor account, a user account, a trust account and an investment account and a computerized computer for performing the transferring of funds and the management of the different accounts. Burke and Hartt et al also describe and contain all the structural and functional relationships of a computerized system for performing the claimed invention. The timing and reallocation of funds do not affect the structure and functionality of the computerized system of Burke and Hartt et al. As such the Examiner asserts that the timing of reallocating funds in the system of Burke and Hartt et al would have been obvious to one of ordinary skill in the art to do based on the decisions and arrangements as would have been agreed by all the involved parties or entities.

2. The prior rejection is repeated below.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US Patent No. 5,621,640) in view of Hartt et al (WO 94/04979).

As per claims 30, 31, 33 and 34, Burke discloses all the claimed limitations with the exception of the manner of distributing a transaction amount in a user trust account for investing for the user. Note the entire document. Burke states that an investment amount may take the form of extra charges or excess payment made on a transaction. See columns 2 and 3 of Burke.

These investment amounts are invested in a bank, financial institution or are made as payments toward a credit card. See the entire document. Reports are transmitted to the customer. Note columns 2 and 3 of Burke.

Burke does not explicitly state “electronically distributing the portion reallocated from the transaction amount from the vendor account to a trust account using at least one electronic system, wherein the portion allocated from the transaction amount in the user trust account is placed in a user investment vehicle for the user”.

Hartt et al disclose an investment system wherein funds are being transferred from a vendor’s account to an escrow account and then to a user investment vehicle for the user. See pages 3, line 23 to page 4, line 30 of Hartt. Both Hartt et al. and Burke disclose providing periodic statements to the user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Burke by incorporating the transferring of funds system of Hartt therein. The motivation would have been to provide an automatic transfer system wherein funds are transferred in a more secure manner, and at the same time encouraging consumers to purchase at a desired vendor.

As per claim 31, Burke discloses providing a user’s account and a vendor’s account. Hartt et al disclose a user account, a vendor account and at least one user trust account. See the respective document, and the above motivation for combining Hartt et al and Burke.

As per claim 32, Burke discloses that a user may possess a bank account, one or more credit or debit accounts. See column 2, lines 16-29 of Burke. Hartt et al also discloses various types of investment accounts as the user investment account. Thus, the combination of Hartt et

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al and Burke teach maintaining a second user account as an investment account. It would have been obvious to one of ordinary skill in the art to note that the newly created investment vehicles or accounts are second accounts of the customers or vendors in which profits or the allocated funds may be deposited or invested thereto for profit purposes.

As per claim 33, a user account may be a credit card account, a checking account and a savings account which may be used as payment for a transaction and/or as re-payment when there is an excess of change in a particular transaction.

As per claim 34, note the discussion above in respect to claim 30 regarding the claimed trust account. Means for providing an interaction between the trust account/bank regarding portion of a transaction amount being placed in an investment vehicle is taught on page 4, lines 20-29 of Hartt et al.

As per claims 35 and 36, the combination of Burke and Hartt et al does not explicitly teach means of accessing the website or a kiosk. Accessing a website or a kiosk with means of accepting electronic cards are well known in the art. Providing such in the combined system of Burke and Hartt et al would have been obvious to one of ordinary skill in the art at the time of the invention in order to facilitate financial transactions to remote users and to users who can independently process electronically financial transactions without help of a sales clerk.

Claims 37, 40, 42 and 43 are system claims directing to computer components for performing the claimed functions recited in independent claim 30 above. These components would have been obvious to one of ordinary skill in the art when viewing the combined teachings of Burke and Hartt et al where it is disclosed various computer systems and subsystems for

implementing the claimed invention. For example, a credit card issuer is a financial institution having at least one transaction processing unit for maintaining users' accounts or credit cardholders' accounts. Similarly, a vendor or merchant will have at least one computer system having a vendor account transaction processing unit for handling vendors' account transactions.

As per claims 38 and 39, having a user account manager and a vendor account manager in the combined system of Burke and Hartt et al is not explicitly stated. Such would have been obvious to one of ordinary skill in the art to do therein in order to facilitate the functioning of the overall system (such as accounts updates and transferring of funds to/from accounts) in a well-organized manner. It should be noted that Hartt et al allow various types of accounts. See figure 1 of Hartt et al., as these various types of accounts would have been managed by an account manager for providing user or clients with updated information related to their accounts.

As per claim 41, it would have been obvious to one of ordinary skill in the art to note in the combination of Burke and Hartt et al that the newly created investment vehicles are second accounts of the customers or vendors in which profits or allocated portions may be deposited or invested thereto. See the above discussion.

As per claims 44 and 45, see the rejection regarding claims 35 and 36 above.

As per claim 46, when the vendor transfers funds to a user account, this fund or portion of this fund may be transferred to the investment's vehicle. Note the teachings above with respect to claim 30 above. The added limitation of "electronically receiving...proximate in time to said transaction... using an electronic system" is taught by Hartt et al. See pages 3 and 4 of Hartt et al.

Claims 47-51 contain features recited in respective claims 3-7 and these claims are rejected under a similar rationale.

As per claim 52, see the rejection regarding claim 30 above.

As per claim 53, note the rejection of claim 38 above.

As per claims 54-58, note the rejection of respective claims 41-45 above.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 6:30AM to 5:00PM..



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3628**

FP  
September 21, 2006